

REMARKS

Claims 51-62 are pending and currently under consideration in the present application. Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Examiner will be addressed below in the order they appear in the prior Office Action.

1. Applicants note with appreciation that the amendment filed September 14, 2001 has been entered in full.

2. Applicants note that the Information Disclosure Statement filed January 16, 2001 has been acknowledged.

3. Regarding the date to which the present application may rightfully claim priority. Applicants respectfully disagree with the effective filing date suggested by the Examiner in the previous Office Action. The present application is a continuation under 37 CFR 1.53(b) of United States Serial Number 08/360,144, filed December 20, 1994. Applicants enclose herewith a copy of the Request for a Continuation under 37 CFR 1.53(b) which accompanied the application filed March 3, 2000 (enclosed herewith as Exhibit 1). Applicants note that the Request properly indicated that the present application is a continuation of United States Serial Number 08/360,144, filed December 20, 1994. Additionally, the Request included an amendment to the specification to explicitly reference the application to which the present application claims priority. Accordingly, Applicants contend that the present application is a direct continuation of and properly claims priority to United States Serial Number 08/360,144, filed December 20, 1994. The effective filing date of the present application is therefore December 20, 1994.

4. Claims 51-62 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 2, 6-7, 9, 11, 13 and 16-17 of U.S. Patent No. 6,464,974. Applicants will submit a terminal disclaimer, if necessary, upon indication of allowable subject matter.

5. Claims 51-62 are rejected under 35 U.S.C. 112, second paragraph, as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter that Applicants

regard as their invention. Applicants traverse this rejection and contend that the rejection is moot in light of the amended claims.

a. The Examiner alleges that recitation of the term "immunoreactive" is unclear because an antibody allegedly has no reaction other than binding to a particular protein. Applicants contend that the term immunoreactive is not only defined in the specification but is an art recognized term used to refer to the specific association between an antibody and an antigen. Given the extensive use of this term in the art, one of skill in the art would readily understand the metes and bounds of the claimed subject matter. Nevertheless, to expedite prosecution of claims directed to commercially relevant subject matter, Applicants have amended the claims. Applicants' amendments are not in acquiescence to the rejection. Furthermore, as pointed out by the Examiner, the term "immunoreactive" refers to the binding or association of an antibody and an antigen. Accordingly, Applicants' amendments to the claims do not narrow their scope. Reconsideration and withdrawal of this rejection is requested.

b. The claims are rejected because recitation of the term "substantially cross-react" is allegedly unclear. Specifically, the Examiner contends that the degree of cross reactivity represented by the term is unclear. Applicants traverse this rejection. The specification provides an extensive description as to the meaning of the term "substantially cross-react." Applicants direct the Examiner's attention to page 40, lines 27-36.

For instance, a favored anti-RAP-BP antibody of the present invention does not substantially cross react (i.e. react specifically) with a protein which is less than 90 percent homologous to one of SEQ ID Nos: 2, 12 or 24; though antibodies which do not substantially cross react with a protein which is less than 95 percent homologous with one of SEQ ID Nos: 2, 12 or 24, or even less than 98-99 percent homologous with one of SEQ ID Nos: 2, 12 or 24, are specifically contemplated. By "not substantially cross react", it is meant that the antibody has a binding affinity for a non-homologous protein (e.g. a yeast TOR1 or TOR2 protein) which is less than 10 percent, more preferably less than 5 percent, and even more preferably less than 1 percent, of the binding affinity for a protein represented one of SEQ ID Nos: 2, 12 or 24.

In accordance with MPEP 2173.05(b), "[t]he fact that claim language, including terms of degree, may not be precise, does not automatically render the claims indefinite under 35 U.S.C. 112, second paragraph. *Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221.

USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification."

In light of the direction provided by the MPEP and the courts, Applicants submit that the rejection to the claims over the recitation of the term "substantially" should be withdrawn. In fact, Applicants point out that one of the specific examples cited in the MPEP concerns the examination of claims which contain the relative term "substantially". The MPEP refers to two cases in which the courts held that the limitation "substantially" was definite based on the guidance provided in the specification. *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975); *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988). Accordingly, in light of the specification, Applicants contend that one of skill in the art can readily understand the metes and bounds of the claimed invention. Reconsideration and withdrawal of this rejection is requested.

6. Claims 51-62 are rejected under 35 U.S.C. 102(b) as allegedly anticipated by or, in the alternative, under 35 U.S.C. 103(a) as allegedly obvious over Berlin et al. (WO 95/33052). Applicants traverse this rejection.

Applicants respectfully point out that the cited reference is not available as prior art under 35 U.S.C. 102(b). As outlined in detail above, the present application is a continuation of U.S. Serial Number 08/360,144, now U.S. Patent No. 6150137, filed December 20, 1994. Given that the present application is a direct continuation of U.S. Serial Number 08/360,144, the claimed subject matter is rightfully entitled to claim priority to December 20, 1994. Accordingly, the cited reference, which became publicly accessible on December 7, 1995, is not available as prior art under 35 U.S.C. 102(b). Reconsideration and withdrawal of this rejection is respectfully requested.

Applicants further point out that the cited reference is not available as prior art under 35 U.S.C. 103(a). Firstly, as outlined in detail above, the claimed subject matter is rightfully entitled to claim priority to December 20, 1994 – a date nearly one year **before** the publication of the cited reference. Additionally however, Applicants point out that the present application and the cited reference are the products of the same inventive entity. Given that 35 U.S.C. 103(a) requires that the cited reference is the work of "another," Applicants contend that the cited

reference is not available as prior art under 35 U.S.C. 103(a). Reconsideration and withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks. Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Respectfully Submitted,

Date: July 1, 2003

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